

**REMARKS****Summary of the Office Action**

In the Office Action, claims 1-2 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,687,515 to Kosaka (hereinafter "Kosaka").

Claims 3-5 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosaka.

**Summary of the Response to the Office Action**

Applicants have amended claims 1 and 3 to differently describe embodiments of the instant application. Moreover, claims 6-9 are canceled without prejudice or disclaimer. Accordingly, claims 1-5 remain pending for consideration.

**The Rejections under 35 U.S.C. §§ 102(e) and 103(a)**

Claims 1-2 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kosaka. Claims 3-5 and 7-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosaka. Claims 6-9 have been canceled without prejudice or disclaimer. To the extent that these rejections might be deemed to apply to the remaining claims 1-5 as newly-amended, they are respectfully traversed as follows.

The Office Action asserts that Kosaka teaches all of the limitations of independent claim 1 in its current form. Kosaka teaches a wireless video telephone having an ambient light sensor. When an image is to be transmitted by the telephone of Kosaka, the ambient light sensor determines if the present ambient light level is too dark. If the detected

ambient light level is too dark, a brightness warning is displayed and image transmission stops.

Applicants respectfully traverse the rejection of claim 1 under 35 U.S.C. § 102(e) at least because Kosaka does not teach or suggest a portable telephone combination including at least the “permission signal sending part” as recited in the claim. The Office Action alleges at page 3, lines 1-5 that this feature is taught by Kosaka’s disclosure, at col. 2, line 63 – col. 3, line 30, of “the received base signal process band performed after the IMAGE key is pressed for transmission and receipt of voice and data.” As described at page 4, lines 16-19 of the instant application’s specification, this feature of the instant application only allows the monitoring of an image when a permission signal is sent that matches a password previously set by the user. As a result, there is no danger of a third party’s access to the image.

The Office Action’s cited portion of Kosaka with regard to this claimed feature merely involves a user depressing an IMAGE key on a telephone keypad in order to commence transmission of a video signal from a camera on the telephone. There does not appear to be any associated security password functionality disclosed by Kosaka in this regard. Even further, at page 4, lines 11-13, the Office Action concedes that the “image signal sending permission part” feature is not disclosed by Kosaka. While Applicants believe that the original claim language distinguished from the applied Kosaka reference in the foregoing respects, Applicants have nevertheless opted to amend claim 1 even further to even more specifically recite the above-discussed “password” feature.

With regard to independent claim 3, the Office Action concedes that Kosaka does not disclose the recited “monitoring camera device which is connected to said portable telephone ... obtained by imaging.” The Office Action also concedes that Kosaka does not disclose “an image pickup part which is installed and oriented toward a desirable object to be monitored ...” Even further, the Office Action concedes that Kosaka does not disclose “an image signal sending permission part...” as discussed previously. However, the Office Action goes on to assert that while these features are “not taught directly by Kosaka, it would have been obvious ... that Kosaka’s system is capable of performing the aforementioned functions.”

As an example, the Office Action alleges that “if two of the portable video phones, as taught by Kosaka, are communicating with each other, then it will be possible to monitor or observe a ‘desirable object’ from the called end side and deliver that image to the image pick-up part of the calling side portable phone.” Applicants respectfully traverse this assertion at least because the applied Kosaka reference does not teach, or even suggest, such an arrangement, and such an arrangement would only be obtained in hindsight after reviewing the disclosure of the instant application.

It is well understood that MPEP § 2141, under the heading "Basic Considerations Which Apply to Obviousness Rejections," points out that "the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention." [See also Hodosh v. Block Drug Co., Inc., 786 F.2d 1136, 229 USPQ 182 (Fed. Cir. 1986).] The Federal Circuit has clearly held that "the motivation to combine references cannot come from the invention itself." Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21 F.3d 1068, 30 USPQ 2d 1377 (Fed. Cir. 1993).

Accordingly, an assertion could be made that absent any teaching or suggestion *in the prior art* to adapt the teachings of Kosaka to meet the claimed invention, the rejection under 35 U.S.C. § 103(a) is improper.

Moreover, even assuming, strictly arguendo, that one having skill in the art would be motivated to reach the feature contemplated by the Office Action, the Office Action's asserted of "if two of the portable video phones, as taught by Kosaka, are communicating with each other, then it will be possible to monitor or observe a 'desirable object' from the called end side and deliver that image to the image pick-up part of the calling side portable phone" is respectfully traversed in that the recited features of installing and orienting an image pickup part towards a desirable object would still not be met. For example, the Office Action's asserted arrangement does not include an installation of a monitoring camera device.

Even further, the Office Action's asserted arrangement would require another individual to be present in the caller's home in order to answer the incoming call and direct the called phone to the desired object. This would be inconsistent with an important object of embodiments of the instant application that involve allowing a homeowner to remotely check on the status of their home with their wireless telephone, for example, via the pre-installed image pickup part when nobody is home. Nevertheless, it is clear that the Office Action's asserted contemplation is well beyond any disclosure of Kosaka and would only be attained through hindsight after reviewing the disclosure and claims of the instant application. While Applicants believe that the original language recited in original independent claim 3 distinguished from the applied Kosaka reference

in the foregoing respects, Applicants have nevertheless opted to amend claim 3 even further to even more specifically recite the above-discussed "password" feature.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because Kosaka does not teach or suggest each feature of independent claims 1 and 3, as amended. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Furthermore, Applicants respectfully assert that dependent claims 2 and 4-5 are allowable at least because of the dependence from their respective independent claims and the reasons set forth above.

### **CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request withdrawal of all outstanding rejections and the timely allowance of this application. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be

required, including any required extension of time fees, or credit any overpayment to

Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE**

**PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: March 14, 2005

By:



Paul A. Fournier

Reg. No. 41,023

**CUSTOMER NO. 009629**

**MORGAN, LEWIS & BOCKIUS LLP**

1111 Pennsylvania Avenue, N.W.

Washington, D.C. 20004

Tel: 202-739-3000

Fax: 202-739-3001